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Customer No.: 07278

Docket No.: 02338/000A887-US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert FISCHER, Uwe WAGNER, Jürgen FREITAG,
Johannes BRAUN, and Anton RINK

Serial No.: 08/392,127 Art Unit: 2304

Filed: February 22, 1995 Examiner: Collin W. Park

For: **PROCEDURE TO CONTROL A TORQUE TRANSMISSION SYSTEM**

RENEWED PETITION UNDER 37 CFR §1.137(b)

December 1, 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir,

The above-entitled petition is, more particularly, a request for reconsideration of the October 2, 2003 decision dismissing petitioners' submission of July 29, 2003. A copy of the decision is attached for convenience.

The original petition was dismissed for lack of the following:

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and

(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The required terminal disclaimer is contained in a separate document being filed, together with the requisite fee, contemporaneously herewith.

Further, the October 2, 2003 decision specifies the following:

Petitioner should provide a full explanation for the delay from the date of abandonment until the date the instant petition was filed. Petitioner should provide evidence to establish the entire delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).

It is respectfully submitted that the evidence and discussion provided below satisfy such specification and affirmatively establish that the entire delay from the date of abandonment until the date of the instant petition was filed was unintentional.

A. Background

Originally, a German language forerunner of the present application was sent 1/16/95 by a German corporation (hereinafter "LuK" or "client") to Peter K. Kontler (hereinafter "PKK"), with a copy for the Darby firm (hereinafter "Darby") in New York, together with an instruction that it be filed in the USPTO on or before 2/23/95. At that time, PKK was Of Counsel to Darby, but located in Naples, FL, not its New York City office. Copies of PKK's English language fax letters of 1/19/95 to Darby and LuK that succinctly memorialize the urgency of the situation are attached hereto behind Tab 1. Today, Darby has such file in its custody in New York City.

The undersigned avers, however, that the Darby file is not complete. It contains an unsigned draft of a declaration and power of attorney, but no copy of the signed version. Such draft names the partners of Darby, including Melvin C. Garner and Henry Sternberg (hereinafter "HS"), but does not mention PKK. Nor is there a copy of an associate power from a Darby partner to PKK.

B. USPTO Office Action Mailed 11/12/96

The USPTO office action of 11/12/96 was duly docketed by Darby on receipt and reported in the normal course to LuK by HS on 11/22/96. And, in his letter, HS expressly requested instructions by 1/12/97 and confirmation that PKK was to prepare the response. See the copy thereof attached hereto behind Tab 2.

LuK sent back its instructions on 2/6/97 with an explicit and unequivocal request that they and the Darby file be forwarded to PKK. HS had a copy of the office action sent to PKK on 3/6/97. It also appears that copies of HS' letter to LuK and its instructions back were faxed to PKK on 3/4/97. Copies of this correspondence are attached hereto behind Tab 3.¹

In a 5/12/97 e-mail, Gail Pelkowski, then a Darby paralegal, informed Gabriela Karaszi, then a Darby docketing person, as follows:

I spoke with Mr. Kontler today regarding the response to the office action due today for file no. 2238/0A887-US0, S.N. 08/392,127. Mr. Kontler is working on the response. He intends to fax it to the PTO himself this evening.

See the copy attached hereto behind Tab 4. Also, Darby invoice no. 175900, dated 7/25/97, a redacted copy of which is attached hereto behind Tab 5, contains a line as follows:

5/12/97 Several telecoms HS with PKK

But the USPTO table of contents for its corresponding file reflects no receipt of any PKK response to the 11/12/96 office action. A copy of the table of contents is attached hereto behind Tab 6.

¹ Note should be taken that only the first paragraphs of the 2/6/97 letter have been translated into English from German, because, effectively, the rest of the 2/6/97 letter from client to counsel that sought to advance the prosecution of the present application in the USPTO was put into English and incorporated in the amendment filed with the 7/29/03 petition to revive herein; accordingly, such translation requires no repetition here.

It should also be noted that all of the documents attached hereto behind Tabs 1 to 16 are included for the relevant facts that they evidence. To the extent that such documents contain attorney fee information or requests for, or offers of, legal advice or opinion, they have been redacted.

A possible explanation of the foregoing chain of events is that PKK did in fact fax his response to the USPTO, but it deemed the submission a nullity because PKK lacked any corresponding power of attorney. However, nothing in the Darby file or what the undersigned has seen of the USPTO file substantiates this. The other possibility is that PKK sent no fax, or any other form of a, response to the USPTO office action of 11/12/96 at any time. Notwithstanding our diligent attempts to investigate the matter with Mr. Kontler, we have had no response from him concerning this omission.

C. USPTO Notice of Abandonment Mailed 5/27/97

On 5/27/97, the Darby & Darby Docket Manual 1995 authoritatively spelled out the applicable procedure or rules governing the firm's docketing function. Copies of the manual's title page, its Table of Contents page i to v and its subsection B. Notice of Abandonment is Received from USPTO (pages 37 and 38) are attached hereto behind Tab 7.

Numbered sub-paragraphs 5 to 7 of such sub-paragraph B plainly required that Darby's actual receipt of any and all notices like the subject 5/27/97 USPTO notice of abandonment must be memorialized in several ways, i.e.,

- 1) entry in PATTSY (the Darby docketing computer);
- 2) entry in its IDB (hard-cover Incoming Docketing book);
- 3) entry on the cover of the Darby case file; and
- 4) an entry of the Docketing Department's "due date" stamp on the notice itself.

There is a reason why Darby has built such a redundancy into its docketing system. It is to make sure that everyone at the firm coming into contact with a patent application has received some form of notice of the notice of abandonment. It is also to make sure a repetition of the any past failure to respond timely by one or the other of the prior response due dates is prevented. It is to prevent what would, in the worst circumstances, turn out to be an irretrievable loss to the client and Darby. Clearly, the Darby docketing ideal is that no notice of abandonment response due date should be allowed to escape attention and, to this end, should be red-flagged throughout the Darby docketing system.

But such ideal was defeated in this case; there was here no compliance with a single one of the four above-recited requirements.

Behind Tab 8 attached hereto is a copy of a computer print screen of this case showing no entry of the 5/27/97 notice of abandonment. Behind Tab 9 hereof is a copy of the Darby IDB page² that should have shown, but did not, the 5/28/98 due date for response to such notice. Behind Tab 10 is a copy of the Darby file cover for this case, showing no entry for such notice. Behind Tab 11 is a copy of the Darby file copy of the 5/27/97 notice of abandonment from which the prescribed Darby Docketing "due stamp" is entirely missing. **Thus, each and every Darby specified docketing requirement for such a USPTO notice was violated in this case due to clerical errors, and as a consequence, this negated the client's intention to respond to the office action of 11/12/96 and maintain pendency.**

For stark contrast, the facts are that the USPTO office action of 11/12/96 (a copy of the first page of the file copy of which is attached behind Tab 12) bears the Darby docketing "due date" stamp and was otherwise duly docketed in compliance with parallel Darby procedures. Cf., attached Tabs 8 and 10 and note that the computer print screen of Tab 8 expressly sets forth both USPTO due dates, i.e., 2/12/97 and 5/12/97, for response to the office action of 11/12/96. See, also, Tab 13 behind which are copies of the Darby IDB pages highlighted to show such 2/12/97 and 5/12/97 due dates for response to such office action.

Notwithstanding the foregoing demonstration that the 5/27/97 notice of abandonment was never formally docketed by Darby, the existence of the notice was timely, if informally, brought to the attention of HS and PKK. See the copy of the two-page 6/4/97 fax sent by Ema Gualano, secretary to HS, to PKK that is attached hereto behind Tab 14.

The undersigned avers that there is nothing in the Darby file of this case that reflects any PKK reaction whatsoever to such 6/4/97 fax.

² Note that it was then Darby Docketing's practice to re-use certain pages of its 1997 IDB for 1998 due dates and certain pages of its 1996 IDB for 1997 due dates.

The significance of such a substantial docketing failure, particularly in a law firm as big and as busy as Darby, cannot be disputed. It means, that, having already missed the two separate office action response due dates afforded by the USPTO that were properly entered on the Darby docketing computer, no further notice-of-abandonment response due date was entered thereon by human hands. And, no additional capacity to help itself in this regard existed within the commercial computer software on which the system relied. Hence, after the initial receipt of the notice of abandonment, it could only vanish from the sight of any Darby attorney for a longer term simply because no mention of it could appear on any routine attorney docket generated by the firm's docketing computer; absence from PATTSY of any remark thereof (see Tab 8) assured no later appearance on any attorney docket month after month after month.

Indeed, it is clear to the undersigned that, had the client not written Darby on 4/2/03 to ask HS about the status of this case, the original (7/29/03) petition to revive would not yet have been filed (see Tab 15 for a copy of the letter in German accompanied by a translation thereof into English).

D. Post 4/2/03 Events

Copies of the correspondence emanating from the client and HS (and ultimately directed to PKK) in the period 4/8/03 to 5/15/03 are attached hereto behind Tab 16, together with translations from the German of those portions relevant to the present request for reconsideration.

Of the exhibits attached hereto behind Tab 16, the client's letter of 5/15/03 is the most significant. For, the letter establishes that the client had no prior knowledge of any failure to respond timely to the office action of 11/12/96 and no knowledge prior to 4/8/03 of the 5/27/97 notice of abandonment. **Clearly, in the absence of evidence of any such knowledge and for the periods of time involved, no intent to delay responses to either USPTO action can be imputed to the client.**

Also included behind Tab 16 is a copy of HS' 5/15/03 fax to PKK. **The undersigned avers that the Darby file in this matter contains no PKK response of any**

kind thereto and, further, there is therein no evidence that contradicts either of the client's above-noted assertions of no prior knowledge.

More generally, the documents behind Tab 16 establish that anxiety was full-blown by 5/15/03 about whether PKK had filed a timely response to the office action of 11/12/96. Note, in particular, the tone of HS' 5/15/03 letter to PKK requesting information about such response and acknowledging the lack of a copy in Darby's New York City office. But PKK did not respond, and has remained entirely unresponsive.

E. Conclusion

It is respectfully submitted that there is no proof anywhere that there has been any intentional delay in the filing of the petition to revive in this case. The present record clearly proves that the present petition to revive was not intentionally delayed at any time beginning with the response due date for the 11/12/96 office action and up to the actual 7/29/03 filing date of the petition to revive and this response. It may or may not show inadequate communication between client and counsel or among counsel but these are not the issues to be decided here. The sole issue is delay and it was purely and entirely unintentional. Accordingly, reconsideration and withdrawal of the dismissal of such petition, and its early grant, are respectfully solicited.

All statements made herein of the undersigned's knowledge are true, and all statements made on information and belief are believed to be true; and further the statements were made with the knowledge that willful statements and the like are made punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that

such willful false statements may jeopardize the validity of the present application or any patent issuing thereon.

Respectfully submitted,


Walt Thomas Zielinski
Walt Thomas Zielinski
Reg. No. 18,902
Attorney for Petitioners

DARBY & DARBY, P.C.
Post Office Box 5257
New York, N.Y. 10150-5257
Phone (212) 527-7700

|

01/19/95 19:08

1 813 434 6747

KONTLER

DARBY

001/006

2338/0A887

PETER K. KONTLER
4401 Gulf Shore Blvd. N.
Naples, Florida 33940

BY TELECOPIER ON 1/19/95

Melvin C. Garner, Esq.
DARBY & DARBY, P.C.
805 Third Avenue
New York, N.Y. 10022-7513

Re: New US patent application of
Messrs. Robert FISCHER et al.
assigned to LuK Getriebe-Systeme GmbH
LuK File GS 0115/04/012 B US
Priority dated February 23, 1994

Dear Mr. Garner:

Enclosed please find a copy of a cover letter which was received today, together with a German text including 111 pages and 39 Figures. Please let me know the D&D File Number of the case. Thank you.

The LuK letter of January 16, 1995 contains the statement that another application, having the same priority, is now in preparation in Germany and is expected to be sent to me in the near future. I will send you a copy of the letter which will accompany the new application immediately upon receipt.

Yours very truly,

Peter K. Kontler

Peter K. Kontler

Enclosures:
(5 pp.)

PETER K KONTLER

PATENT LAWYER

4401 GULF SHORE BOULEVARD NORTH
NAPLES, FLORIDA 33940

PER FERN SCHREIBEN AM 19.1.95

TELEPHONE: 813 262-8492
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Herrn Dipl.-Ing. Gerhard Rotter
Leiter der Patentabteilung
LuK Lamellen und Kupplungsbau GmbH
Industriestrasse 3
D-77815 Bühl/Baden
Bundesrepublik Deutschland

Re: New US patent application
of Messrs. Robert FISCHER et al.
Ihr Neuer Zeichen GS 0115/24/012 B US
(LuK Getriebe-Systeme GmbH)

Dear Mr. Rotter:

Thank you for your letter of January 16, 1995
with enclosures (received January 19, 1995).

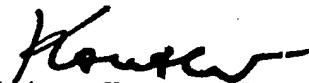
The US patent application is in preparation and
will be filed in the US Patent and Trademark Office prior to
expiration of the Convention priority period.

I would appreciate receiving the necessary documents
for the preparation of the new US patent application corres-
ponding to your case GS 0116*B at your early convenience.
Thank you.

Please send me prints of DE-OS 31 30 871 (mentioned
in line 1 on page 24 and elsewhere in your German text) and
DE-PS 37 12 223 (mentioned in line 10 on page 26 and elsewhere
in the German text), preferably by telecopier (if they are
not too bulky). You may also wish to send me prints of
US patents Nos. 5,029,087 and 5,577,737 (referred to, res-
pectively, in lines 11 and 19 on page 24 and elsewhere in
your German text). Please let me know if the US patents
are too bulky for sending by telecopier, and I will order
copies of such patents from my Washington correspondents.

I wish to thank you for entrusting me with the pre-
paration of the US patent application, and remain,

yours faithfully,


Peter K. Kontler

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Darby & Darby

Professional Corporation

805 Third Avenue • New York, NY 10022-7513
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707 Wilshire Boulevard • Los Angeles, CA 90017-3514
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(212) 527-7755
Reference:
2338/0A887

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November 22, 1996

* Admitted in California only
† Admitted in Virginia only
‡ Admitted in DC and
○ Pennsylvania only
• Admitted in Nebraska only
** Admitted in Florida only

VIA DHL

Herrn Dipl.-Ing. Gerhard Rotter
Leiter der Patentabteilung
LuK Lamellen und Kupplungsbau GmbH
D-77813 Bühl
Federal Republic Germany

Re: U.S. Serial No. 08/392,127
For: METHOD OF AND APPARATUS FOR
TRANSMITTING TORQUE IN VEHICULAR
POWER TRAINS
Your Ref: GS 0115/04/012 B US

Dear Mr. Rotter:

Enclosed is a copy of an Official Action dated 12 November 1996.

Claims 41-101 stand withdrawn from further consideration as being directed to non-elected inventions.

Claims 1-40 stand rejected under Section 112, second paragraph, as being indefinite.

Claims 1-40 stand further rejected under Section 112, first paragraph. The Examiner has taken the position that although determination of factors K_{var} , M_{var} and M_{cont} are critical to the claimed invention, there is not enough guidance by the present disclosure regarding selection or determination of the above factors to enable one of ordinary skill in the art to make and use the present invention.

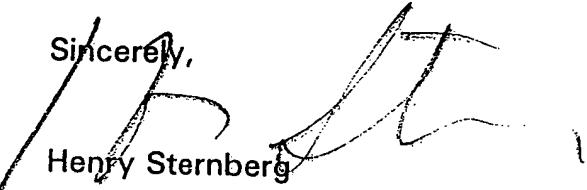
The Examiner has further taken the position that it is not possible to reasonably interpret the scope of the claims in light of the alleged deficiencies cited above so that no prior art has been cited at this time.

Herrn Dipl.-Ing. Gerhard Rotter
Page 2
November 22, 1996

A response to the Official Action must be filed no later than 12 February 1997, if late fees are to be avoided.

Please let us have your instructions no later than 12 January 1997. At that time, also please confirm that you wish the response to be prepared by Mr. Kontler.

HS/kmw
Enclosure

Sincerely,

Henry Sternberg

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Translation of the beginning of attached letter on LuK
letterhead, up to "Sehr geehrter Herr Kontler"

VIA TELECOPIER

Darby & Darby
Professional Corporation
Attn. Mr. H. Sternberg
805 Third Avenue
NEW YORK, NY 10022-7513
USA

Bühl, February 6, 1997

US Patent Application No. 08/392,127
Title: "Method of Controlling a Torque-Transmitting System"
Your Reference: 2338/0A887
Our Reference: GS 0115/04/012 B US

Dear Mr. Sternberg:

May we ask you to send the aforementioned file to Mr. Kontler
for the continuation of the work in this matter.

Dear Mr. Kontler:

November 3, 2003

To Whom It May Concern:

The undersigned hereby declares that he has personally translated the attached documents:

Portions of fax from Dr. H. Grauel, LuK, to Henry Sternberg, dated February 6, 1997,

Fax from Mr. Ronnenberg, LuK, to Henry Sternberg, dated April 2, 2003, and

Fax from Mr. Rotter, LuK, to Henry Sternberg, dated May 15, 2003

and that they are accurate translations of the German documents that are attached to them.



Walter Kupper
Registered Patent Agent
USPTO Reg. No. 34,954

KUPPLUNGEN · TELLERFEDERN · LAMELLEN

LAMELLEN UND
KUPPLUNGSBAU GMBH

By Telecopier #723

LuK Lamellen und Kupplungsbau GmbH - 77813 Bühl

DARBY & DARBY
Professional Corporation
Attn. Mr. Henry Sternberg
805 Third Avenue
New York, N.Y. 10022-7513

Ø H. Kontler**U S A**Telefon: (072 23) 9 41-0
Fax: (072 23) 2 88 50Lieferanschrift:
Industriestraße 3
77815 Bühl

Ihr Zeichen/Ihre Nachricht vom	Abteilung/Bearbeiter	Telefon (Durchwahl) 941-	Fax (Durchwahl) 941-	Rühl, den
	PT/Grech	410/411		6. Februar 1997

US-Patentanmeldung Nr. 08/392,127**Ihr Zeichen: 2338/0A887****Unser Zeichen: GS 0115/04/012 B US****Sehr geehrter Herr Sternberg,****wir bitten Sie, obige Akte Herrn Kontler zur weiteren Bearbeitung zu übersenden.****Sehr geehrter Herr Kontler,****wir kommen zurück auf das Schreiben von Darby & Darby vom 22.11.96 bezüglich des Prüfungsbescheides vom 12.11.96.****Bezüglich des Punktes 6 sei bemerkt, daß die fehlende Anmeldenummer 08/375,913 ist.****Bitte erledigen Sie die Beanstandung bezüglich der Tabelle auf S. 97 von sich aus.****Unter Punkt 7 führt der Prüfer eine Reihe von Unklarheiten an. Hierzu nehmen wir wie folgt Stellung:****Zu 7.1.****Bitte erledigen Sie diesen Punkt von sich aus. Der Prüfer rügt, daß das Drehmoment des Antriebsaggregates unterschiedlich ist zu dem von der Kupplung übertragbaren**

Drehmoment, wobei durch die Ansteuerung des Kupplungsmomentes ja erst der Wert des übertragbaren Drehmomentes festgelegt wird, unabhängig davon, wie groß das anstehende Motormoment ist. Somit sollte deutlich sein, daß das Motormoment und das Kupplungsmoment nicht zwingend gleich sein müssen.

Zu 7.2:

Bitte nehmen Sie in den Anspruch 2 die vom Prüfer geforderten Schritte zur Bestimmung der Korrekturwerte auf. Die Korrektur des k_{me} -Wertes durch den Korrekturwert k_{corr} sorgt dafür, daß ein im wesentlichen fest gewählter k_{me} -Wert durch den Korrekturfaktor entsprechend der Figur 27 betriebspunktabhängig wird. Das Produkt $k_{me} \times k_{corr}$ ist somit abhängig von dem aktuellen Betriebspunkt, also beispielsweise von der Motordrehzahl oder dem Motormoment oder von anderen Größen.

Zu 7.3:

Bitte ändern Sie die Rückbeziehungen des Anspruches 6, so daß der Anspruch 6 auf Anspruch 2 rückbezogen ist.

Zu 7.4:

Bitte erledigen Sie diesen Punkt unter Berücksichtigung der ursprünglichen deutschen Ansprüche 9 und 10 von sich aus.

Zu 7.5:

Statt „eine eindeutig durch eine nicht analytische Technik beschrieben werden“ sollte es heißen: „kann nicht eindeutig analytisch beschrieben werden“.

Zu 7.6:

Entsprechend dem ursprünglichen Anspruch 13 sollte es in Anspruch 15 nicht heißen „establishing an I return flow of fluid from one of the compartments into the other of the compartments“, sondern „by establishing an I feed-back, ...“. Die I-Rückführung stellt somit ein regelungstechnisches Element dar, bei welchem einem PID-Regler der I-Anteil alleine rückgeführt wird. Somit liegt ein I-Regler vor.

Zu 7.7:

Bitte erledigen Sie diesen Punkt von sich aus.

Zu 7.8:

Anspruch 22 sollte dahingehend geändert werden, daß bei einer Signalisierung einer gewünschten Beschleunigung des Fahrzeuges durch den Fahrer, der Schlupf in der Kupplung erhöht wird, und dies wird mittels einer Reduzierung des k_{me} - Faktors erreicht und dadurch wird die vom Wandler angebotene Drehmomenterhöhung als zusätzliche Drehmomentreserve genutzt. Insofern ist die Nutzung der Antriebseinheit in verschiedenen Gängen in diesem Anspruch nicht nötig.

Zu 7.9:

Bitte behabten Sie diese Beanstandung von sich aus.

Zu 7.10:

Der Anspruch 24 ist aufgrund seines nahezu identischen Wortlautes und seines gleichen Sinngehaltes zu streichen. Falls Sie einen Unterschied zwischen Anspruch 23 und 24 sehen, möchten wir Sie bitten, uns diesen mitzuteilen.

Zu 7.11:

Bitte streichen Sie die Formulierung „such as a combustion engine“. Statt dem Wort „variable“ in Zeile 9 des Anspruches 25, sollte es besser heißen: „by the clutch is detectable by a monitoring unit in conjunction with a central computer unit and variable by the computer unit and ...“. Weiterhin sollte in den Anspruch 25 die Bestimmung der Korrekturfaktoren aufgenommen sein. Weiterhin rügt der Prüfer, daß der k_{me} - Faktor zumindest im wesentlichen über den gesamten Betriebsbereich des Fahrzeuges konstant ist. Dies kann in dem vorliegenden Anspruch gestrichen werden, wobei erwähnt sein sollte, daß das Produkt von $k_{me} \times k_{corr}$ nicht konstant sein muß. Weiterhin rügt der Prüfer den Anspruch 25 ab Zeile 24 als nicht klar. Wir möchten Sie bitten, diesen Absatz entsprechend umzuformulieren, damit die Passage dem letzten Absatz des Anspruches 21 der deutschen Unterlagen entspricht und die vom Prüfer gerügte Unklarheit beseitigt ist.

Zu 7.12:

Bitte passen Sie die Ansprüche 26 bis 29 entsprechend dem Obengesagten an.

7.13 bis 7.22:

Bitte erledigen Sie diese Punkte von sich aus.

Der Prüfer weist unter Punkt 8 die Ansprüche 1 bis 40 zurück, da er der Ansicht ist, daß diese Elemente enthalten, die nicht in der Beschreibung derart offenbart sind, daß sie der Fachmann nachvollziehen kann. Weiterhin rügt der Prüfer, daß die Korrekturfaktoren k_{corr} , $M_{corr PM}$ und M_{corrwo} nicht ausreichend offenbart sind.

Nach diesseitiger Auffassung ist sowohl in den Ansprüchen als auch in der Beschreibung genügend Offenbarung vorhanden zum einen, wie die Werte gewonnen werden, nämlich entsprechend der Figur 29 und die Verwendung entsprechend den Figuren 28 und 30. Weiterhin wird mehrmals im Text der Beschreibung ausgeführt, daß Korrekturfaktoren, wie beispielsweise der k_{me} -Wert oder ein k_{corr} einen vorbestimmten Wert annehmen kann oder um einen solchen vorbestimmten Wert vermindert werden kann. Insbesondere auf S. 54 der deutschen Beschreibung wird ausgeführt, daß die Korrekturfaktoren in verschiedenen Betriebsbereichen unterschiedlich gewichtet werden und daß beispielsweise der k_{me} -Wert oder die Korrekturfaktoren aus Kennfeldern herausgenommen werden können (s. S. 92 des ursprünglichen deutschen Textes).

In unserer Anmeldung GS 0104 (05/03) A PCT/US sind im wesentlichen ähnliche Ansprüche enthalten, die von der Prüferin als erzielbar erachtet werden. Somit sollten die Korrekturfaktoren, da in der GS 0104 (05/03) A PCT/US ausreichend offenbart, auch in der vorliegenden Anmeldung ausreichend offenbart sein.

Falls Sie bezüglich der Bearbeitung der vorliegenden Anmeldeunterlagen noch Fragen haben, rufen Sie mich bitte an.

Mit freundlichen Grüßen

A K
Lamellen und Kupplungsbau GmbH
- Patentabteilung -
Dr. A. Grauel

ANNETTE MASIELLO PATENT
AND TRADEMARK SERVICES
2001 Jefferson Davis Hwy.
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Please deliver the following pages to:

NAME: Peter K. Kontler, Esq. DOCKET: 2338/0A887
COMPANY: Darby & Darby DEPARTMENT: _____
FAX NUMBER: 941-434-6747 FAX OPERATOR: rkap
SENDER: Annette Masiello DATE/TIME: 3/6/97 - 4:10 pm

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MESSAGE:

Dear Mr. Kontler,

Please find enclosed copy of cover and contents pages of the file history of U. S. Patent Application S. N. 08/392,127, Fischer et al as well as a copy of Paper No. 8, Rejection, dated November 12, 1996. This office action is being forwarded to you directly at the request of Henry Sternberg, Esq., of Darby & Darby of New York City, New York. Please feel free to call us if you have any questions.

Very truly yours,

Annette Masiello

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

ROBERT FISCHER, ET AL.

Serial No: 08/392,127

Examiner: N. Jensen

Filed: February 22, 1995

Group Art Unit: 3502

For: METHOD OF AND APPARATUS FOR TRANSMITTING
TORQUE IN VEHICULAR POWER TRAINS

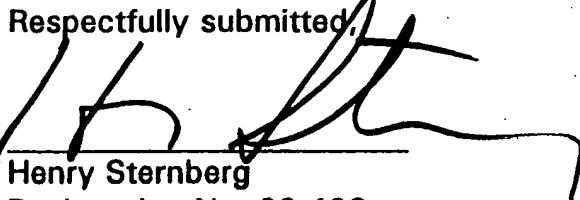
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Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

Please permit Annette Masiello and/or Rayline Petitt of Annette Masiello Patent Services to inspect the file for the above-identified application and to make copies of any of the documents in the file.

Respectfully submitted,


Henry Sternberg
Registration No. 22,408
Attorney for Applicant(s)

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New York, NY 10022
(212) 527-7755

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March 4, 1997

FACSIMILE TRANSMISSION

To: MR. Peter K. Kontler
 941-434-6747
 FAX NO. 1
 From: H. Sternberg, Esq.
 No. 74 pages

Re: U.S. Patent Application.
 Serial No. 08/392,127
 For: METHOD OF AND APPARATUS FOR TRANSMITTING
TORQUE IN VEHICULAR POWER TRAINS

Dear Annette:

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Sincerely,
 Henry Sternberg

HS/eag
Enclosure

cc: Peter K. Kontler, Esq.

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Morris Nelson (1948-1996)

March 4, 1997

Ms. Annette Masiello
Annette Masiello Patent Service
2001 Jefferson Davis Highway
Suite 1011
Arlington, VA 22202

Re: U.S. Patent Application
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cc: Peter K. Kontler, Esq.

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Morris Reison (1948-1996)

FACSIMILE TRANSMISSION

To: Mr. KontlerFax No. 941-262-8492From: H. Sternberg, Esq.No. of Pages 2

VIA DHL

Herrn Dipl.-Ing. Gerhard Rotter
 Leiter der Patentabteilung
 LuK Lamellen und Kupplungsbau GmbH
 D-77813 Bühl
 Federal Republic Germany

Re: U.S. Serial No. 08/392,127
 For: METHOD OF AND APPARATUS FOR
 TRANSMITTING TORQUE IN VEHICULAR
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Your Ref: GS 0115/04/012 B US

Dear Mr. Rotter:

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The Examiner has further taken the position that it is not possible to reasonably interpret the scope of the claims in light of the alleged deficiencies cited above so that no prior art has been cited at this time.

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PKK

PL note.

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1 941 434 0141.4 2

Herrn Dipl.-Ing. Gerhard Rotter
Page 2
November 22, 1996

A response to the Official Action must be filed no later than 12 February 1997, If late fees are to be avoided.

Please let us have your instructions no later than 12 January 1997. At that time, also please confirm that you wish the response to be prepared by Mr. Kontler.

Sincerely,

HS/kmw
Enclosure

Henry Sternberg

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Morris Wilson (1948-1996)

March 4, 1997

FACSIMILE TRANSMISSION

To: MR. Peter K. Kontler
 Fax No. 941-434-6747
 From: H. Sternberg, Esq.
 #G. 14 Pages 1

Re: U.S. Patent Application
 Serial No. 08/392,127
 For: METHOD OF AND APPARATUS FOR TRANSMITTING
 TORQUE IN VEHICULAR POWER TRAINS

Dear Annette:

Please obtain for us a copy of the Official Action dated November 12, 1996, in the above-identified application. As soon as you have it, please fax a copy to Mr. Kontler at 941-434-6747. A Power to Inspect is enclosed.

Sincerely,


 Henry Sternberg

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cc: Peter K. Kontler, Esq.

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Morris Reison (1948-1996)

March 4, 1997

FACSIMILE TRANSMISSION

To: MR. Peter K. Kontler
Fax No. 941-434-6747
From: H. Sternberg, Esq.
No. of Pages 1

Re: U.S. Patent Application
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HS/eag
Enclosure

Sincerely,
Henry Sternberg

cc: Peter K. Kontler, Esq.

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Federal Republic Germany

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Morris Nelson (1948-1996)

FACSIMILE TRANSMISSION

To: Mr. Kontler
Fax No. 941-262-8492
From: H. Sternberg, ESG
No. of Pages 2

VIA DHL

Herr Dipl.-Ing. Gerhard Rotter
Leiter der Patentabteilung
LuK Lamellen und Kupplungsbau GmbH
D-77813 Bühl
Federal Republic Germany

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Page 2
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Sincerely,

HS/kmw
Enclosure

Henry Sternberg

H

From: Gpelkows
To: gkaraszi
Date: Monday, May 12, 1997 12:21 pm
Subject: 2338/0A887-US0

I spoke with Mr. Kontler today regarding the response to the Office Action due today for File No. 2338/0A887-US0, S.N. 08/392,127. Mr. Kontler is working on the response. He intends to fax it to the PTO himself this evening.

5

IN ACCOUNT WITH
DARBY & DARBY
PROFESSIONAL CORPORATION

803 THIRD AVENUE
NEW YORK, N.Y. 10022-7513
(212) 527-7700

CLIENT NUMBER 2338
INVOICE NUMBER 175900

ATTORNEYS AT LAW

LuK Incorporated
3401 Old Airport Road
P.O. Box 798
Wooster, Ohio 44691

FILE COPY

July 25, 1997

0A887- PROFESSIONAL SERVICES RENDERED THROUGH
MAY 30, 1997 IN CONNECTION WITH THE
FOLLOWING MATTER:

U.S. PATENT APPLICATION
PROCEDURE TO CONTROL A TORQUE
TRANSMISSION SYSTEM
ASSIGNEE: LuK GETRIEBE SYSTEMS
INVENTORS: FISCHER ET AL.
YOUR REF: GS 0115/04/012B US

11/22/96 Reporting Office Action and requesting instructions
for response.
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5/12/97 Several telecons HS with PKK.

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PATENT APPLICATION

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1. Application 24 papers.

2. Priority paper 2/22/95

3. CPO (Ott FBD) 2/24/95

1-11 4. Restriction (30 days) 1-18-96 Cew

3/19 5. Election 2-20-96

6. Restriction 30 days 5-23-96 Sze

7. Response to Restriction 06-01-96

11-8 8. Ref. (3) 11-12-96

9. Power to inspect 03-06-97

5-27 10. Notice of abandonment 5-07-97

11. Power to inspect 6/21/03

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POSITION	ID NO.	DATE
CLASSIFIER	5	3-14-95
EXAMINER	BDY	3-28-95
TYPIST	339	
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GROUP SPEC. HAND		
FILE MAINT.		
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INDEX OF CLAIMS

Claim	Date
1	96 5 1/1/96
2	96 76 1/1/96
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SYMBOLS

- ✓ Rejected
- = Allowed
- (Through number) Cancelled
- Restricted
- ↑ Non-elected
- I Interference
- A Appeal
- O Objected

Claim	Date
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51	96 76 1/1/96
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Fix Table
of Contents

DARBY & DARBY

DOCKETING MANUAL

1995

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-
2. Forwarded remaining copies to Patent Services who will forward them to the client.

XIV. Abandonment

A. Application is Abandoned at Client's Request

1. If application is abandoned by the request of the Client, forward the file to Docketing with the client's letter.
2. Update the "Status" field in PATTSY to reflect the abandonment.
3. Update the file cover.
4. Cross out any due date entries in the IDB.
5. Forward the file to the Records Department.
6. If there are pending related cases, the file remains in the file room. If not, send the file to the responsible attorney with a file storage memo attached, so that it can then be routed to storage.

B. Notice of Abandonment is Received from the USPTO

1. The Records Department stamps the back of the document, pulls file and forwards it to Docketing.
2. Check the Serial Number with the file to insure they are accurate.
3. Check the reason for the Notice of Abandonment.
4. If the Notice was issued in error, attach a "Memorandum re Notice of Abandonment Advisory" sheet.
5. Docket the due date in PATTSY and the IDB for 1 year from the due date up to which an extension was paid (or from 1 year from the Notice), for submitting a Petition to Revive.
6. Stamp the Notice with the "Due Date" stamp.
7. Update the file cover with the pertinent information.
8. Forward the file to the responsible attorney.

C. Petition to Revive

1. If the Patent was mistakenly abandoned a Petition to Revive needs to be filed with the USPTO. The following circumstances are reasons that a patent would be abandoned in error:
 - a. USPTO error;
 - b. non-payment of maintenance fee; or
 - c. failing to respond to an outstanding Office Action.
2. All Petitions to Revive files are forwarded to Joseph Lerch.

XV. Maintenance Fees

A. Docketing Maintenance Fees

1. Applications filed on or after December 12, 1980 have the following Maintenance Fees due:
 - a. at 3.5 years;
 - b. 7.5 years; and
 - c. 11.5 years, provided maintenance fees are paid.
2. A United States Patent expires after 17 years.

B. USPTO Maintenance Fee Receipt Received

Forward the Receipt to Patent Services for handling.

XVI. Communication from the Examiner is Received from the USPTO

A. General Information

1. Normally a Communication does not require a response.
2. There are exceptions to this rule. One example of an exception is that a Reply Brief was submitted to the USPTO and this Communication noted that it will not be entered (see 37 CFR 1.181 for a description on how to handle this matter).

2. Forwarded remaining copies to Patent Services who will forward them to the client.

XIV. Abandonment

A. Application is Abandoned at Client's Request

1. If application is abandoned by the request of the Client, forward the file to Docketing with the client's letter.
2. Update the "Status" field in PATTSY to reflect the abandonment.
3. Update the file cover.
4. Cross out any due date entries in the IDB.
5. Forward the file to the Records Department.
6. If there are pending related cases, the file remains in the file room. If not, send the file to the responsible attorney with a file storage memo attached, so that it can then be routed to storage.

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1. The Records Department stamps the back of the document, pulls file and forwards it to Docketing.
2. Check the Serial Number with the file to insure they are accurate.
3. Check the reason for the Notice of Abandonment.
4. If the Notice was issued in error, attach a "Memorandum re Notice of Abandonment Advisory" sheet.
5. Docket the due date in PATTSY and the IDB for 1 year from the due date up to which an extension was paid (or from 1 year from the Notice), for submitting a Petition to Revive.
6. Stamp the Notice with the "Due Date" stamp.
7. Update the file cover with the pertinent information.
8. Forward the file to the responsible attorney.

8

Darby# 000A887-US0

PRINTED ON: 10/31/2003

COUNTRY	US	UNITED STATES	TITLE						
NEW/CON	NEW	SERIAL#	08/392,127	METHOD OF AND APPARATUS FOR TRANSMITTING TORQUE IN VEHICULAR POWER TRAINS					
RELATED		PATENT#							
TYPE	UTL	STATUS	PENDING						
CLIENT	03192	LuK Getriebe-Systeme GmbH		1	CREF	GS0115/04/012B US			
AGENT					AREF				

ID	O	ACTION	BASE	DUE IN	DUE	EXTNS	FINAL	EXT	RESPONSE	CALL UP	1	2	P
DL	N	PRIORITY DEADLINE	2/23/1994	12 M	2/23/1995		2/23/1995	0	2/22/1995	1 M	Y	Y	Y
SPEC. DECL. (24) INFML DWGS,PRI DOCS (4), ASSGN, PTO-1595, IDS													
CF	Y	CORRECT OF FLG RCPT	4/20/1995										
DS	N	INF DISCLOSURE STMT	2/22/1995	3 M	5/22/1995	0	5/22/1995	0	2/22/1995	1 M	Y	Y	N
6 REFS													
RR	N	RESTRICTION REQUIRE	1/18/1996	30 D	2/17/1996	4 1	6/17/1996	0	2/14/1996	1 M	Y	Y	N
RR	N	RESTRICTION REQUIRE	5/23/1996	30 D	6/22/1996	4 1	10/22/1996	0	6/18/1996	1 M	Y	Y	N
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PE	Y	PETITION	7/29/2003										
	N	F/U PETITION	10/14/2003	0 M	10/14/2003		10/14/2003	0	10/2/2003	10 D	Y	Y	Y
DISMISSED													
QR	N	REQ RECONSIDERATION	10/2/2003	2 M	12/2/2003	4 1	4/2/2004	0		1 M	Y	Y	N

INVENTORS

ROBERT FISCHER; UWE WAGNER;

JURGEN FREITAG;

JOHANNES BRAUN; ANTON RINK

ASSIGNEES

LUK-GETRIEBE-SYSTEME GMBH

REC DATE 02/22/95 R/F 7370/0711

USER-DEFINABLE FIELDS				PATENT FIELDS			
TEXT 1				SMALL ENTITY	no	ART UNIT	
TEXT 2				CLAIMS		EXAMINER	
Old#	0A887US0			PUBLICATION#		CONFIRM#	

P0A887US00 ENTERED 1/20/1995 MODIFIED 10/10/2003 BY DBP ATTORNEYS JRR / HS / IH / HS

FILE LOCATION

FILE/SUBFILE#	LOC
0A887US0	SJM
0A887US0V1	WTZ
000A887-US0	WTZ
000A887-US0R1	WTZ

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~~SPL Major 6120/05331 397,808 File to Resave. 5/27~~
~~ALN LRC 6870/30432 249,147 File to Oppose~~
~~HR Garrison 154112D05900 PCT US 98/05180 INV 10 CORR 5/26~~

ATN Bergman 1329 / DC405 734.83 Issue Fee + Dues -
5/21
ECS Cor. 02/13/1994 vs 1 678.48 ~~Unfinished~~ 350.23 397.88 + Dues
5/21
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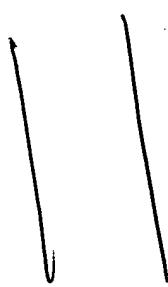
Client <u>LUK</u>		Div. or Cont. of Continuation in part of	D & D ON MFT
Inventor <u>ROBERT FISCHER; UWE WAGNER; JÜRGEN FREITAG;</u> <u>JOHANNES BRAUN + ANTON RINK</u>			
Serial No. <u>081392127</u>		Filed <u>02/22/95</u>	
Title <u>PROCEDURE TO CONTROL A TORQUE</u> <u>TRANSMISSION SYSTEM</u>			
Assignee <u>LUK-GETRIEBE-SYSTEME GMBH</u>			
Assignment Recorded <u>02/22/95</u>		Reel <u>7370</u>	Frame <u>0711</u>
OFFICE ACTIONS	AMENDMENTS		
	<u>6515/04/020 ROBERT FISCHER; UWE WAGNER; JOHANNES BRAUN Inventor</u>		
	<u>3/23/95 2003 (24) PCT/DE/000 000 001, 105, 070, 114/94 REC'D. 5 PCT., DECL. MS (14), PTO-1595, INFO.</u>		
	<u>4/20/95 REC'D. FOR LTR. PCT/DE RECEIPT</u>		
February 17, 1996	2/14/96 Reop		
JUNE 22, 1996	6/18/96 Reop		
11/12/96 February 12, 1997 (5/12/97)			
REDWELD <u>2</u> OF <u>2</u> Pabinett #1			
NOTE: SEE REWELD FOR EXTRA DOCS. FILING RECEIPT CHECKED BY <u>SO</u> DATE <u>07/01/95</u>			
Small Entity Status - Yes <input type="checkbox"/> , Filed <input type="checkbox"/> , No <input type="checkbox"/>			
Allowed <input type="checkbox"/> Final Fee Paid <input type="checkbox"/> YES <input type="checkbox"/> NO <input type="checkbox"/>			
Patent No. <u>2,123,194</u> Date <u>11/16/95</u>			
Priority Claimed <u>2,123,194</u> Docs. Fwd.			

PROJECT BILL



P C

PATSY
Entered 1/30/04 SGN
Docketed _____





FILE
FILE

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/392, 127	02/22/95	FISCHER	R 2338/DA887

DARBY AND DARBY
805 THIRD AVENUE
NEW YORK NY 10022

B3M1/0527

EXAMINER	
PARK, C	
ART UNIT	PAPER NUMBER
2304	1D

DATE MAILED:

05/27/97

NOTICE OF ABANDONMENT

This application is abandoned in view of:

1. Applicant's failure to respond to the Office letter, mailed 11/12/96.
2. Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
3. Applicant's failure to timely file the response received _____ within the period set in the Office letter.
4. Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of _____ of the Notice of Allowance.
 - The issue fee was received on _____.
 - The issue fee has not been received in Allowed Files Branch as of _____.

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17(l), and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of Delgar Inc. v. Schuyler, 172 U.S.P.Q. 513.

5. Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by _____ as required in the last Office action.
 - The corrected and/or substitute drawings were received on _____.
6. The reason(s) below.

Collin W. Park

COLLIN W. PARK
PRIMARY EXAMINER
GROUP 2300

12



UNITED STATES DEPARTMENT OF COM.
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/392, 127	02/22/95	FISCHER	R 2338/0A887 HS

DARBY AND DARBY
805 THIRD AVENUE
NEW YORK NY 10022

E3M1/1112

EXAMINER

DATE:	February 12, 1997	PAPER C	ART UNIT	PAPER NUMBER
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Docketed on 11/12/97 by 2304 8

Docketed without file

Attorney

DATE MAILED: 11/12/96

11/12/97

5/12/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 6/12/96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 1 - 101 are pending in the application.

Of the above, claims 41 - 101 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1 - 40 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received; not been received; been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in

13

1997

1996 43rd day - 323 days follow
Lincoln's Birthday

Week

MONDAY

12

FEBRUARY

ALN CHEMICAL 5555 36502 1,634,474
 AB INGRIA 7723 06262 1,634,360
 SPL 21113 2005 06588 1,635,175
 ALN PAPELL 6177 37058 1,634,820
 SPL LONDON 6070 36259 1,634,663 SEC. 8 6 15 1/14
 BT EVEN 3051 06777 1,634,765 ~~NO NO P/M COUNT~~ SEC. 8 6 15 1/13
 BT KUMARAN 10421 08819 11 MOS.
 AOA Recondato 0485 08087 NO U/F Client No - Drouallen
 PSO Shinjuku 0762 1007009 719,224 SEC. 8 6 15 1/13
 ABS PREMIER 011 0411 30011 038,137 SIX MONTHS
 OI MINDA 1103132024 045,990 Six Months 1/9
 AOH Plazamara 1041 30028 060,991 SIX MONTHS 1/12
 JKL CHAHAM 0046 08123 416,201 Next Reg +4 10/1
 MAE LOMIS 5422 00921 101,592 V. NETEL PLAINTIFF TO CLATE 3/10
 IPI BML 2408 08086 641,214 RENEWAL DONG/14
 HMF CASALOU 5442 08754652 IDS 2/5
 OIC U.S. DIA 1777 03005 472,999.3 final 2/12
 MTCI YAMADA 8032 07536 907,926 Final
 MTCI Chertlach 1955 0807 444,962 Regs abandon 12/13
 HS UK 2338/04887 392,127 Regs
 JPC Organamic 0046 1A074US1 455,355 Regs
 HS Luk 2338/78279154 320,732 Final
 HS Luk 2338/09451 211,978 Final
 C. Allende 0582 100375 072,188 Regs 2/10
 BSL Contra 54108/000007 Request for Refund
 PHATHE 2001 20474100 96,98415 9mos forward ext 3/12
 DGL Baff 1780 20474100 96,18414 9mos 2/12
 HGC Loker 3258/37324 061,557 Six Months 2/10
 KGH GENG 0665/08858443 567,341 FILE CONTINUATION APPN.
 AOA KRAFT 3520 10894 84,210 EPC v. PRODUCE MARKET SURVEY &
 JK/PY Lubbell 4335/62323 Peterson v Chickens Chickens v Lubbell Reply
 MWH BETHLEHEM 1144/62293 111,094+4. deposition (HARRY) 2/19

ROAL LUK 2338/09277US1 533,110 1,181,000 fee 2/12
 JPC 54108PHEN 1447 09013 231,622 DULCE + 3 11/10
 JPC 34XMO10 3404 1104410155 425,133 DULCE + 3 11/12
 HMF Goudreau 5795/03139 137,700 JNGS + 3 9/30

1996 133rd day - 233 days follow
Mother's Day

SUNDAY 12 MAY

LPN BM 21081/00086 611,244 REINHAL + 9 DATE 12/4
PR 18 U.S. ORDER 111100005 472,999 APPROVED allowance
MFG SHIMADA 8032 107540 407926 APPROVED ALLOWED 4/7
MFG SHIMADA X 04761/00086 63,651 5/14 MFG SHIMADA 5/12
MFG MOBILATECH 1955 100022 441,700 SIX MONTHS APPROVED 12/13
MFG UK 2338/0A887 392,127 • SIX MONTHS APPROVED 12/13
MFG SHIMADA 06461/1A674651 455,355 • SIX MONTHS APPROVED 12/13
MFG ALUMA 07751/33889 398,134 SIX MONTHS APPROVED 12/13
MFG THOMPSON 09041/362688 083,650 SIX MONTHS APPROVED 5/12
HS 2nd 03381/182794 USY 320,732 APPEAL 4110
HS 2nd 2338/09451 211,978 APPEAL knowed.
JPL ATTENDEE 0522 106375 012,188 SIX MONTHS 2/10
HS 153 14541/00044 716,341 DATE 14/4 1/6
HS 153 15119815 Maria v. Mattis 103,287 Defendant to file answer EXT 5/10
HS TOPACK 0600/0C1697 • IDS 6/24
HS SUP 2938/00033 FILE APPAL 5/2
PUL ADAPTIVE 0382/12A913 11591/03445 REGG TO WILLEN APPROVED 5/2
PUL CH JACOB H05/0A161 (18 mo) FILE APPAL 5/1
JPL ATTENDEE 0270/189102 • RESPONSE TO SUBPOENA 5/27

MFG SHIMADA 04761/00086 684,951 ISSUE FOR 4/23
HS 2nd 2338/09451 211,978 • ISSUE FOR 5/9

14

From: gkaraszi
To: gkaraszi
Date: Monday, May 12, 1997 12:21 pm
Subject: 2338/0A887-US0

I spoke with Mr. Kontler today regarding the response to the Office Action due today for File No. 2338/0A887-US0, S.N. 08/392,127. Mr. Kontler is working on the response. He intends to fax it to the PTO himself this evening.

MR. KONTLER: 6/4/97
Please let us know when you want to proceed with the petition to revive?
Thank you -
EMR



PCL

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/392,127	02/22/95	FISCHER	R 2338/DA887

B3M1/0527

DARBY AND DARBY
805 THIRD AVENUE
NEW YORK NY 10022

EXAMINER	
PARK, C	
ART UNIT	PAPER NUMBER
2304	10

DATE MAILED:

05/27/97

NOTICE OF ABANDONMENT

This application is abandoned in view of:

1. Applicant's failure to respond to the Office letter, mailed 11/12/96.
2. Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
3. Applicant's failure to timely file the response received _____ within the period set in the Office letter.
4. Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of _____ of the Notice of Allowance.

The issue fee was received on _____.

The issue fee has not been received in Allowed Files Branch as of _____.

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17(l), and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of Delaney v. Schuyler, 172 U.S.P.Q. 513.

5. Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by _____. _____ as required in the last Office action.
- The corrected and/or substitute drawings were received on _____.

6. The reason(s) below.

FACSIMILE TRANSMISSION

To: Mr. Kontler

Fax No. 941-434-6747

From: H. Sternberg, Esq.

No. of Pages 2

*PLEASE SEE
ATTACHED*

Collin W. Park

COLLIN W. PARK
PRIMARY EXAMINER
GROUP 2304

15

Translation of the attached letter on LuK letterhead

By Telefax

Darby & Darby
Professional Corporation
Attn. Mr. Henry Sternberg
805 Third Avenue
NEW YORK, NY 10022-7513
USA

Bühl, April 2, 2003

US Patent Application Serial No. 08/392,127

Your Reference: 2338/0A887

Our Reference: GS 0115/04/012 B US

Dear Mr. Sternberg:

In reference to the above-identified case, the last activities in our file are:

our letter to you dated February 6, 1997 (see attachment)
and

your invoice dated July 25, 1997.

Please advise what is your latest status in this matter.

Sincerely

LuK Lamellen und Kupplungsbau
Beteiligungs KG
Patent Department

(signature of Dieter Ronnenberg)

Ronnenberg

November 3, 2003

To Whom It May Concern:

The undersigned hereby declares that he has personally translated the attached documents:

Portions of fax from Dr. H. Grauel, LuK, to Henry Sternberg, dated February 6, 1997,

Fax from Mr. Ronnenberg, LuK, to Henry Sternberg, dated April 2, 2003, and

Fax from Mr. Rotter, LuK, to Henry Sternberg, dated May 15, 2003

and that they are accurate translations of the German documents that are attached to them.



Walter Kupper
Registered Patent Agent
USPTO Reg. No. 34,954

LUK

**LuK Lamellen und Kupplungsbau
Beteiligungs KG**

Industriestraße 3 · 77815 Bühl
Postfach · 77813 Bühl
Tel. 0 72 23/941-0 (Zentrale)

Abteilung/Bearbeiter PT/Ron
Telefon (Durchwahl) 941-7054
Fax (Durchwahl) 941-149
Dieter.Ronnenberg@luk.de

Bühl, den 02.04.03

LwK Lamellen und Kupplungsbau Befestigungs KG · 77811 Bräunlingen

Per Telefax

DARBY & DARBY
Professional Corporation
Attn. Mr. Henry Sternberg
805 Third Avenue
NEW YORK, N.Y. 10022-7513
U.S.A.

US Patentanmeldung Serial No. 08/392 127

Ihr Zeichen: 2338/DA88Z

Unser Zeichen: GS 0115/04/012 B LJS

Sehr geehrter Herr Sternberg

bezüglich dem obigen Fall, sind in unserer Akte:

unser Schreiben an Sie mit Datum 6. Februar 1997 (siehe Anlage) und

Ihre Rechnung mit Datum vom 25. Juli 1997
die letzten Vorgänge.

Wir bitten um Mitteilung, welches Ihr letzter Stand ist.

Mit freundlichen Grüßen

LuK Lamellen und Kupplungsbau
Beteiligungs KG
Patentabteilung

Dieter Ronnenberg
Ronnenberg

Ronnenberg

Bankverbindungen:
Deutsche Bank AG
08/57 700 00, BLZ 662 700 01

Volkspark Böhl

Rechtsform:
LuK Lamellen und Kupplungsbau Beteiligungsg. KG
mit Sitz in 77015 Bochum

luXner
www.luX.de

כ. ט. ג. 6000 נ. י. מ.

16

Translation of the attached letter on LuK letterhead

VIA FACSIMILE

Darby & Darby
Professional Corporation
Attn. Mr. H. Sternberg
805 Third Avenue
NEW YORK, NY 10022-7513
USA

Bühl, May 15, 2003

Our Patent Application in the U.S.A. No. 08/392,127
Title: "Method of Controlling a Torque-Transmitting System"
Your Reference: 2338
Our Reference: GS 0115/04/012 B US

Dear Mr. Sternberg:

After we noticed that for a long time following our fax of February 6, 1997 to you there had been no activities whatsoever in the above-referenced case which we still counted among our active cases, we asked you in a letter in February this year to let us know what is your latest status in this matter.

You advised us in a fax of April 8 of the current year, that a Notice of Abandonment exists with a date of May 27, 1997. However, the Notice of Abandonment was not attached to your fax.

Subsequently we asked you in a fax dated April 11 of this year to send us the Notice of Abandonment. The Notice of Abandonment then arrived with a copy of this letter of April 8, 2003.

The matter presents itself to us as follows:

We asked you in our fax of February 6, 1997 to send the files to Mr. Kontler for the continuation of the work on them.

We further asked Mr. Kontler in the same fax of February 6, 1997 to respond to the office action of November 12, 1996 based on the information contained in the aforementioned fax.

Next came the Notice of Abandonment of May 27, 1997.

Thus, the office action of November 12, 1996 has not been responded to, even though we supplied detailed information in our already mentioned fax of February 6, 1997.

The Notice of Abandonment is at least not in our file. We also have to conclude that it has never been received by us, and should you disagree, please send us the fax report.

If we had at least received the Notice of Abandonment, we would with certainty

This will
certainly require a discussion.

We would like to know your position on how you see this matter.

Sincerely

LuK Lamellen und Kupplungsbau
Beteiligungs KG
- Patent Department -

(signature of Mr. Rotter)

G. Rotter

November 3, 2003

To Whom It May Concern:

The undersigned hereby declares that he has personally translated the attached documents:

Portions of fax from Dr. H. Grauel, LuK, to Henry Sternberg, dated February 6, 1997,

Fax from Mr. Ronnenberg, LuK, to Henry Sternberg, dated April 2, 2003, and

Fax from Mr. Rotter, LuK, to Henry Sternberg, dated May 15, 2003

and that they are accurate translations of the German documents that are attached to them.



Walter Kupper
Registered Patent Agent
USPTO Reg. No. 34,954



AS

LuK Lamellen und Kupplungsbau Beteiligungs KG • D-77813 Bühl

VIA FACSIMILE
DARBY & DARBY
 Professional Corporation
 Attn: Mr H. Sternberg
 805 Third Avenue
 New York, NY 10022-7513
 USA

DA 887

LuK Lamellen und Kupplungsbau**Beteiligungs KG**

Bußmatten 2 • 77815 Bühl

Postfach • 77813 Bühl

Tel. 0 72 28/941-0 (Zentrale)

Abteilung/Bearbeiter PT/Ro-mcc
 Telefon (Durchwahl) 0 72 28/941-410
 Fax (Durchwahl) 0 72 28/941-149
 eMail: guido.ege@tuk.de

Bühl, den 15.05.2003

Unsere Patentanmeldung in den USA Nr. 08/392,127 vom 22.02.1995.**Titel:** "Verfahren zum Steuern eines Drehmomenten-Übertragungssystems"**Ihr Zeichen:** 2338**Unser Zeichen:** GS 0115/04/012 B US

Sehr geehrter Herr Sternberg,

nachdem wir festgestellt hatten, dass lange Zeit in der obigen Anmeldung, die für uns noch zu den laufenden Anmeldungen zählte, nach unserem Fax an Sie vom 06. Februar 1997 keinerlei Aktivitäten erfolgt sind, haben wir Sie mit Schreiben vom 02. dieses Jahres um Mitteilung gebeten, welches Ihr letzter Stand in der Akte ist.

Sie teilten uns mit Fax vom 08. April dieses Jahres mit, dass eine Notice of Abandonment vom 27. Mai 1997 vorläge. Diesem Fax war jedoch die Notice of Abandonment nicht beigefügt.

Daraufhin haben wir mit Fax vom 11. April dieses Jahres gebeten, uns die Notice of Abandonment zuzusenden. Mit einer Kopie dieses Schreibens vom 08. April 2003 kam dann die Notice of Abandonment.

Uns stellt sich die Angelegenheit wie folgt dar:

Mit unserem Fax vom 06. Februar 1997 haben wir Sie gebeten, die Akten an Herrn Kontler zur weiteren Bearbeitung zu übersenden.

14. Mai 2003



Seite 2 von 2

Weiterhin haben wir mit gleichem Fax vom 06. Februar 1997 Herrn Kontler gebeten, auf den Prüfungsbescheid vom 12. November 1996 unter Zugrundelegung der in obigem Fax enthaltenen Informationen zu erwidern.

Als Nächstes kam die Notice of Abandonment vom 27. Mai 1997.

Der Prüfungsbescheid vom 12. November 1996 ist also nicht beantwortet worden, obwohl wir in unserem bereits genannten Fax vom 06. Februar 1997 ausführliche Informationen geliefert haben.

Die Notice of Abandonment vom 27. Mai 1997 haben wir zumindest nicht in unserer Akte. Wir gehen auch davon aus, dass sie nie bei uns eingetroffen ist, und sollten Sie anderer Auffassung sein, so lassen Sie uns bitte Ihren Faxbericht zukommen.

Wenn wir wenigstens die Notice of Abandonment erhalten hätten,

Hier-

Über wird sicherlich noch eine Diskussion erforderlich sein.

Wir hätten gerne Ihre Stellungnahme, wie Sie die Angelegenheit sehen.

Mit freundlichen Grüßen

LuK Lamellen und Kupplungsbau
Beteiligungs KG
– Patentabteilung –

G. Rotter

*** TX REPORT ***

TRANSMISSION OK

TX/RX NO	1849
CONNECTION TEL	011497223941149
SUBADDRESS	
CONNECTION ID	
ST. TIME	04/08 16:46
USAGE T	01'15
PGS. SENT	4
RESULT	OK

(OK)

ENR

ARB Y &
ARB YPERSONAL
CREATION

ELECTUAL PROPERTY LAW

April 8, 2003

HENRY STERNBERG
OF COUNSEL
(212) 527-7755
hsternberg@darbylaw.com

THIRD AVENUE
YORK, NY 10022-7513
(212) 527-7700
(212) 753-6237

Reference: 2338/0A887

VIA FACSIMILE- 011 49 7223941149

Herrn Dipl.-Ing. Gerhard Rotter
Leiter der Patentabteilung
LuK Lamellen und Kupplungsbau Beteiligungs KG
Bussmatten 2,
77815 Bühl,
Federal Republic Germany

Attn: Mr. Ronnenberg

Re: **U.S. Patent Application**
Serial No. 08/392,127
Your Ref: GS 0115/04/012 B US

Dear Mr. Ronnenberg:

Pursuant to your fax of 2 April, we reviewed the file and found that the most recent correspondence was back in 1997. Since we were never instructed to prepare a Petition to Revive after we received a Notice of Abandonment dated 27 May 1997 (copy enclosed for your information), the application is Abandoned.

Any further questions, please let me know.

Sincerely yours,

(H)

*** TX REPORT ***

TRANSMISSION OK

TX/RX NO 3070
CONNECTION TEL 011497223941149 *(DC)*
SUBADDRESS
CONNECTION ID
ST. TIME 04/15 09:32
USAGE T 00'56
PGS. SENT 2
RESULT OK

EMA

DARBY &
DARBY

PROFESSIONAL
CORPORATION

ELECTRICAL PROPERTY LAW

THIRD AVENUE
NEW YORK, NY 10022-7513
(212) 527-7700
(212) 753-4237

April 8, 2003

Reference: 2338/0A887

HENRY STERNBERG
OF COUNSEL
(212) 527-7755
hstemberg@darbylaw.com

VIA FACSIMILE- 011 49 7223941149 (2 pages)

Herr Dipl.-Ing. Gerhard Rötter
Leiter der Patentabteilung
LuK Lamellen und Kupplungsbau Beteiligungs KG
Bussmatten 2,
77815 Bühl,
Federal Republic Germany

Attn: Mr. Ronnenberg

Re: U.S. Patent Application
Serial No. 08/392,127
Your Ref: GS 0115/04/012 B US

Dear Mr. Ronnenberg:

Pursuant to your fax of 2 April, we reviewed the file and found that the most recent correspondence was back in 1997. Since we were never instructed to prepare a Petition to Revive after we received a Notice of Abandonment dated 27 May 1997 (copy enclosed for your information), the application is Abandoned.

Any further questions, please let me know.

11

DARBY &
DARBY

PROFESSIONAL
CORPORATION

INTELLECTUAL PROPERTY LAW

805 THIRD AVENUE
NEW YORK, NY 10022-7513
TEL (212) 527-7700
FAX (212) 753-6237

April 8, 2003

Reference: 2338/0A887

HENRY STERNBERG
OF COUNSEL
(212) 527-7755
hsternberg@darbylaw.com

VIA FACSIMILE- 011 49 7223941149 (2 pages)

Herrn Dipl.-Ing. Gerhard Rotter
Leiter der Patentabteilung
LuK Lamellen und Kupplungsbau Beteiligungs KG
Bussmatten 2,
77815 Bühl,
Federal Republic Germany

Attn: Mr. Ronnenberg

Re: **U.S. Patent Application**
Serial No. 08/392,127
Your Ref: GS 0115/04/012 B US

Dear Mr. Ronnenberg:

Pursuant to your fax of 2 April, we reviewed the file and found that the most recent correspondence was back in 1997. Since we were never instructed to prepare a Petition to Revive after we received a Notice of Abandonment dated 27 May 1997 (copy enclosed for your information), the application is Abandoned.

Any further questions, please let me know.

Sincerely yours,

Henry Sternberg

HS:eag

*** TX REPORT ***

TRANSMISSION OK

TX/RX NO 2648
CONNECTION TEL
SUBADDRESS
CONNECTION ID
ST. TIME 05/16 09:38
USAGE T 03 '28
PGS. SENT 9
RESULT OK

12394346747 AF

Ema

To: Mr. Konoller
From: Ema qualand
Fax: 239-434-6747



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/392,127	02/20/93	FISCHER	R 2394346747 HS
EXAMINER		PAPER ART UNIT PAPER NUMBER	
E3M1/1112		8	

DARBY AND DARBY
605 THIRD AVENUE
NEW YORK NY 10022

DEU: February 12, 1997 PAPER ART UNIT PAPER NUMBER
Received on 1/17/97 by 2304 8
Docketed without file DATE MAILED: 1/17/93
APR 17 1997 5/12/97

This is a communication from the examiner. It is not a final rejection.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 1/21/96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 15 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-292.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 1 - 101 are pending in the application.
Of the above, claims 41 - 101 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1 - 40 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.65 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.64 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

To: MR. KONIKER
 From: Ema qualand
 PAP: 239-434-6747



UNITED STATES DEPARTMENT OF COMMERCE
 Patent and Trademark Office
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/392,127	02/22/95	FISCHER	R 2398/0892 HS

DARBY AND DARBY
 505 THIRD AVENUE
 NEW YORK NY 10022

E3M1/1112

EXAMINER:

DUE: February 12, 1997 **PAPER F** **ART UNIT** **PAPER NUMBER**

Decided on 11/12/97 by 2304

Docketed without file

DATE MAILED: 11/12/96

11/12/97
 5/10/97

This is a communication from the examiner in charge of your application.
 COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 6/21/96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
 Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 1 - 101 are pending in the application.

Of the above, claims 41 - 101 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1 - 40 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

ART UNIT 2304

1. This application has been examined in response to Applicants' communication filed on June 21, 1996. Claims 1-101 are currently pending.

2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

5 3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

4. The restriction requirements mailed on January 18, 1996 (paper number 4) and May 23, 1996 (paper number 6) are incorporated herein.

5 Applicant's election with traverse of Group 1A (claims 1-40) in Paper No. 7 is
10 acknowledged. The traversal is on the ground that a single novelty search would appear to suffice to locate prior art relevant for determining patentability of claims in all of the groups that. This is not found persuasive because a search required for the Group 1A such as class 364, subclass 424.1, for example, is not required for the Group IV which is directed to a mechanical structure.

15 Thus, the requirement is still deemed proper and is therefore made FINAL. Also, claims 41-101 are withdrawn from further consideration by the Examiner as being directed to non-elected inventions. 37 CFR § 1.142(b).

ART UNIT 2304

6. The disclosure is objected to because of the following informalities:

One of the parent applications referenced on page 2 of the specification is not identified by its serial number. The Applicants are requested to update the continuing data as in the specification as well as in the declaration.

5 Further, the table on page 97 of the specification is more than five inches wide. See 37 CFR § 1.58(c). Correction is required.

7. Claims 1-40 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10 7.1 As per claim 1, "selectively variable" (lines 8-9) is vague and indefinite. Also, it is not clear whether the magnitude of torque being transmitted by the output element is different from the magnitude of torque transmitted by the clutch. Finally, the text starting with "ascertaining and adaptively applying" and continuing to the end of the claim is vague and confusing, and does not appear to make any sense.

5 7.2 As per claim 2, there is no recitation of steps for determining the RPM of the output element, for determining k_{corr} , for determining $M_{corr\ pm}$, for determining M_{pm} , and for determining $M_{corr\ wu}$. These steps are necessary for determining the torque to be transmitted by the clutch. Thus, the claim is incomplete. Also, "at least substantially constant within the entire operating range of the power train" is vague and indefinite, and appears to contradict the disclosure (see 0 Figure 27).

ART UNIT 2304

7.3 Claim 6 does not make sense and appears to be meant to depend on claim 2, not claim
1.

7.4 Claim 9 is confusing and does not appear to make sense.

7.5 As per claim 14, "can be unequivocally defined by a non-analytical technique" is
functional and not supported by the recited means/steps.

7.6 As per claim 15, it is not clear what the "I return flow of fluid" means.

7.7 As per claim 21, see the above rejection of claim 2.

7.8 Claim 22, is confusing and does not appear to make sense.

7.9 As per claim 23, "efficiency" (line 4) and "utilization" (line 7) lack proper antecedent
bases.

7.10 Claim 24 is exactly the same in scope as claim 23 because "speed ratios" and "drive
ratios" are the same.

7.11 As per claim 25, the exemplary language "such as a combustion engine" makes the scope
of the claim indefinite. Also, the text starting with "wherein the magnitude of torque being
transmitted" and ending with "regulatable by the computer unit" (lines 7-12) does not make
sense. Further, there is no recitation of steps for determining k_{corr} and for determining M_{pm} .
These steps are necessary for determining the torque to be transmitted by the clutch. Thus, the
claim is incomplete. Also, "at least substantially constant within the entire operating range of
the power train" (lines 18-19) is vague and indefinite, and appears to contradict the disclosure
(see Figure 27). Finally, the text starting with "applying the thus ascertained force" and
continuing to the end of the claim is confusing and does not appear to make sense.

7.12 As per claims 26-29, see the above rejection of claim 25.

ART UNIT 2304

7.13 As per claim 29, there is no recitation of step for determining the RPM of the output element which is necessary for the recited method.

7.14 As per claim 33, it is not clear to what "that torque" (line 2) refers. The recited undertakings (A)-(D) are vague, confusing, and indefinite in scope. For example, see "such as blocking of the clutch" (line 10).

5 7.15 As per claim 34, see the above rejection of claim 33.

7.16 As per claim 35, "likely to develop" (line 3) and "likely to entail" (line 7) make the claim vague and indefinite. Also, "which ensures insulation . . ." is functional and not supported by the recited means/steps.

10 7.17 As per claim 36, see the above rejection of claim 35.

7.18 Claim 37 does not make sense.

7.19 As per claim 38, the claim is incomplete without a step of detecting "indication of intended acceleration of the prime mover." Also, the exemplary language "such as by a change . . ." makes the scope of the claim indefinite.

15 7.20 As per claims 39-40, see the above rejection of claims 23-24.

7.21 The applicants are advised to establish proper antecedent bases for the terms aforementioned and for all other terms without proper antecedent bases which may exist throughout the claims.

7.22 All the dependent claims are rejected or further rejected for incorporating deficiencies 0 cited above from their respective parent claims.

ART UNIT 2304

8. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5 Although determination of factors k_{corr} , $M_{corr\ pm}$ and $M_{corr\ wu}$ are critical to the claimed invention, there is not enough guidance by the present disclosure regarding selection or determination of the above factors to enable one of skilled in the art to make and use the present invention. Since there are three factors that must be selected or determined, the present disclosure does not enable one of skilled in the art to make and use the present invention without
10 undue experimentation.

9. Because it is not possible for the Examiner to reasonably interpret the scope of the claims in light of the deficiencies cited above, it is deemed inappropriate to reject the claims based on prior art at this time. In re Steele, 134 USPQ 292, 295 (CCPA 1962). The Applicants are not to regard this as an indication of allowable subject matter.

15 10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Collin W. Park whose telephone number is (703) 305-9754. The examiner can normally be reached on Tuesday - Friday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska, can be reached on (703) 305-9704. The fax phone number for this
20 Group is (703) 308-5357.

SERIAL NO. 8 - 392,127

7

ART UNIT 2304

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

November 7, 1996

Collin W Park
COLLIN W. PARK
PRIMARY EXAMINER
GROUP 2300

NOTICE OF REFERENCES CITED

SERIAL NO.

08/392,127

GROUP ART UNIT

2304

ATTACHMENT
TO PAPER NO.

8

APPLICANT(S)

Robert FISCHER et al.

U.S. PATENT DOCUMENTS

*		DOCUMENT NO.	DATE	NAME	CLASS	SUB-CLASS	FILING DATE IF APPROPRIATE
	A	5,029,087	7/02/91	Cowan et al.	364	424.1	
	B	5,058,716	10/22/91	Lippe et al.	192	3.33	
	C	5,272,630	12/21/93	Brown et al.	364	424.1	
	D	5,303,616	4/19/94	Palansky et al.	477	63	8/10/92
	E	5,305,663	4/26/94	Leonard et al.	475	123	8/10/92
	F	5,501,309	3/26/96	Walth et al.	192	3.29	7/27/94
	G	5,553,694	9/10/96	Schulz et al.	192	3.3	9/11/95
	H						
	I						
	J						

FOREIGN PATENT DOCUMENTS

*		DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
	L						
	M						
	N						
	O						
	P						
	Q						

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

	R		
	S		
	T		

EXAMINER

Collin W. Park

DATE

11/07/96

* A copy of this reference is not being furnished with this office action.
 (See Manual of Patent Examining Procedure, section 707.05(a).)

The drawings submitted with this application were declared informal by the applicant. Accordingly they have not been reviewed by a draftsperson at this time. When formal drawings are submitted, the draftsperson will perform a review.

Direct any inquiries concerning drawing review to the Drawing Review Branch (703) 305-8404.

*** TX REPORT ***

TRANSMISSION OK

TX/RX NO	2672
CONNECTION TEL	12394346747
SUBADDRESS	
CONNECTION ID	
ST. TIME	05/16 09:25
USAGE T	01'22
PGS. SENT	3
RESULT	OK

To: Mr. Konfier
From: Irma gualand
Fax 239 434-6747



HC

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCK
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08/392,127 02/22/95 FISCHER

R	23943467
EXAMINER	

DARBY AND DARBY
805 THIRD AVENUE
NEW YORK NY 10022

35M1/0523

JENSEN, N	
ART UNIT	PAPER NUMBER

DUE: June 22, 1996 (10/22/96) 6
Docketed on 6/5 by JLS for 3502

DATE MAILED:

This is a communication from the examining Attorney or the Office.
COMMISSIONER OF PATENTS AND TRADEMARKS

05/23/96

Attorney

This application has been examined Responsive to communication filed on 2. 20, 96 This action is made final.

A shortened statutory period for response to this action is set to expire 30 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.	2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948.
3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.	4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.
5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.	6. <input type="checkbox"/>

Part II SUMMARY OF ACTION

1. Claims 1 - 101 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4.

To: Mr. Kohlher
From: Gina Gualand
Fax 202 434 6747



UNITED STATES DEPARTMENT OF
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADE
Washington, D.C. 20231

Hc

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCK
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08/392,127 02/22/95 FISCHER

R 2020/02/22 EXAMINER

DARBY AND DARBY
805 THIRD AVENUE
NEW YORK NY 10022

35M1/0523

JENSEN, N

ART UNIT

PAPER NUMBER

DUE: June 22, 1996 (10/22/96) 6

Decketed on 6/5 by AJS for 3502 DATE MAILED:

This is a communication from the examiner in what is now the file.
Commissioner of Patents and Trademarks

05/23/96

Attorney

This application has been examined Responsive to communication filed on 2.20.96 This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.	2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948.
3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.	4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.
5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.	6. <input type="checkbox"/>

Part II SUMMARY OF ACTION

1. Claims 1 - 101 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims _____ are rejected.

5. Claims _____ are objected to.

6. Claims 1 - 101 are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other _____

EXAMINER'S ACTION

Art Unit: 3502

Part III - DETAILED ACTION

Election/Restriction

1. Receipt of the Response to the Restriction Requirement, received 20 February 1996, is acknowledged. However, upon reconsideration, it is deemed proper to further restrict Group I (claims 1-40 and 66-71) as described in the following paragraph.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group IA. Claims 1-40, drawn to a method for computerized engine-torque-dependent clutch slip regulation classified in Class 364, subclass 424.01.

Group 1B. Claims 66-71, drawn to a torque converter/slip clutch combination wherein the torque transmitted by the clutch is a function of heat or road slope, classified in Class 192, subclass 3.3.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions IA and IB are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IB has separate utility such as use in a system not using engine parameters to determine clutch transmission. See M.P.E.P. § 806.05(d).

Serial Number: 08/392,127

-3-

Art Unit: 3502

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because of the change in the restriction requirement, Applicant is allowed to choose between Inventions IA, IB (as described above), II, III, IV, and V (as described in the Restriction Requirement mailed 18 January 1996, Paper Number 4).
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Jensen whose telephone number is (703) 305-6297. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

XJC
noj

May 16, 1996

CHARLES A. MARMOR
SUPERVISORY PATENT EXAMINER
ART UNIT 3502

*** TX REPORT ***

TRANSMISSION OK

TX/RX NO	2624
CONNECTION TEL	12394346747
SUBADDRESS	(AP)
CONNECTION ID	
ST. TIME	05/15 15:50
USAGE T	01'32
PGS. SENT	4
RESULT	OK

Ema

DARBY & DARBY

PROFESSIONAL
CORPORATION

INTELLECTUAL PROPERTY LAW

805 THIRD AVENUE
NEW YORK, NY 10022-7513
TEL (212) 527-7700
FAX (212) 753-6237

May 15, 2003

Reference: 2338/0A887

HENRY STERNBERG
OF COUNSEL
(212) 527-7755
hsterberg@darbylaw.com

VIA TELECOPIER - 1239-434-6747

Peter K. Kontler, Esq.
Monaco PH 4
4401 Gulf Shore Blvd. N.
Naples, FLA 34103

Re: U.S. Patent Application
Serial No. 08/392,127

Dear Peter:

We just received a fax from Mr. Rotter (copy of 15 May 2003 enclosed). We meticulously searched the files and were unable to find a copy of your Response to the PTO, which was due on May 12, 1997. We also enclose a copy of an E-mail dated May 12, 1997 sent by Mrs. Pelkowski to Ms. Karaszi, in our docket department. A copy of that E-mail is also enclosed.

Hopefully, you have some record of having responded to the Official Action, because we can find nothing in our files. In any event, please phone us and let us know if you have any records at all concerning the subject matter.

Hope you are both well. Looking forward to hearing from you.

Sincerely yours,



UNITED STATES PATENT AND TRADEMARK OFFICE

HS
03192/000A887

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 15

DARBY & DARBY805 THIRD AVENUE DUE: December 2, 2003
NEW YORK, NY 10022Docketed on 10/10 by DP forDocketed without file **COPY MAILED**OCT 02 2003
*4-2-04*In re Application of
Fischer et al.Application No. 08/392,127
Filed: February 22, 1995
Attorney Docket No. 2338/0A887Attorney Jd**OFFICE OF PETITIONS****ON PETITION**

This is a decision on the petition under 37 CFR 1.137(b), filed July 29, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely reply to the non-final Office action mailed November 12, 1996. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on February 13, 1997. A Notice of Abandonment was mailed May 27, 1997.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply,
- (2) the petition fee,
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition does not satisfy requirements (3) and (4) above. Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The delay in filing the instant petition raises a question as to whether the entire delay in filing a petition under 37 CFR 1.137(b) was unintentional. Petitioner should provide a full explanation for the delay from the date of abandonment until the date the instant petition was filed. Petitioner should provide evidence to establish the entire delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).
DISMISSED

W91/14504

See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

GSCB FEB 12 2004